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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/612,101 | 07/01/2003 | Brian Carvill | 128553-1/GP1-0117 | 3430 |
| 43248 | 7590 | 02/16/2006 | EXAMINER | |
| CANTOR COLBURN LLP - GE PLASTICS - SMITH | | | DAVIS, BRIAN J | |
| 55 GRIFFIN RD SOUTH | | | ART UNIT | |
| BLOOMFIELD, CT 06002 | | | PAPER NUMBER | |

1621

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,101

Applicant(s)

CARVILL ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/05 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/11/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/05 has been entered.

Information Disclosure Statement

For clarity of the record, the examiner notes that the entry for reference number 7 of the 12/11/03 IDS, the core reference during prosecution, has not been initialed. This has now been done and a copy of the initialed IDS attached to this Office Action.

Claim Objections

Claim 1 is objected to because of the following informalities: the claim text does not end with a period. Claims must begin with a capital letter and end with a period. MPEP 608.01(m). Appropriate correction is required.

112 Rejections Withdrawn

The rejection of claims 1-26 under 35 USC 112, second paragraph, outlined in the first Office Action (3/31/06), has been overcome by applicant's amendment (5/31/05). The amendment clarified the claim language as appropriate.

The present examiner points out that this rejection was implicitly withdrawn by the previous examiner (simply because no further reference was made to it during the course of prosecution after applicant's amendment), however, for clarity of the record it is explicitly stated here that the rejection has been overcome.

102 Rejections Withdrawn

The rejection of claims 1-3, 5-7, 9-12, 15-19, 24 and 26 under 35 USC 102(b), maintained in the Final Rejection, is withdrawn. The examiner is in agreement with applicant that the cited references cannot anticipate the claims, since they do not disclose each and every element of the claim. The rejection is improper and the examiner regrets the error.

103 Rejections Maintained

The rejections of claims 1-26 under 35 USC 103(a), outlined in detail during the course of the prosecution, are maintained for reasons of record. While applicant's latest arguments have been carefully considered, they are not persuasive.

Applicant states that in the instant claims "...it is clear that the reaction is not halted and a new feed introduced...". That is, applicant argues that the instant process

is a continuous process and that the examiner's interpretation of the claims as encompassing both a continuous process and a batch process (as in the prior art) is incorrect.

However, as applicant is well aware, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F. 3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Thus, the previous examiner's interpretation of the claims as encompassing a continuous process and the batch process of the prior art is wholly justified. This interpretation is also supported by *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963), where it was held that that batch and continuous processes are not patentably distinct. And finally, there is simply nothing in the portion of the claim specifically cited by applicant, as presently written, which restricts the instant process to a continuous process (...determining the *para-para* bisphenol selectivity of the reaction; and adjusting the concentration of the water in the feed based on upon the *para-para* bisphenol selectivity[.]"). One might easily imagine the instant adjustments to the water feed concentration being made over a series of batch runs, rather than during a continuous run. Indeed, the preamble of the claim baldly states: "A process...". That is, *any* process, continuous or batch, consistent with the limitations which follow.

In sum, applicant's argument, at best, would require the improper importation of material from the specification into the claims. However, it is well established that the specification cannot impose a further limitation upon the plain meaning of the claim language. *White v. Dunbar*, 119 US 47, 51-52, 1886 CD 494, 497-498 (1886).

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In order for an invention to be obvious, two things must be found in the prior art: 1) the suggestion of the invention, and 2) the expectation of its success. *In re Vaeck*, 947 F.2d 488, 492, 20 USPQ2d 1438, 1441 (Fed. Cir. 1991). In the instant case, the suggestion to use the water feed concentration as a method to improve the reaction is clearly and explicitly taught by US 5,302,774 (column 1, line 48). The expectation of success is also clearly and explicitly taught by the prior art in the examples, where it is shown that altering the initial water concentration (that is, *controlling* the water concentration) has measurable and beneficial effects on the reaction yield and product purity. Thus, one of ordinary skill in the art at the time of the invention would have clearly understood and found obvious a conclusion that water concentration was a viable method to controlling the reaction and influencing its outcome in a desirable way. And such a conclusion of obviousness would also be supported by case law: It is well established that expected beneficial results are evidence of obviousness of a claimed invention just as unexpected beneficial results are evidence of unobviousness. *In re Skoll*, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975); *In re Skoner*, 517 F.2d 947, 186 USPQ 80 (CCPA 1975); *In re Gershon*, 372 F.2d 535, 152 USPQ 602 (CCPA 1967).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
February 13, 2006